

Serial No. 10/054,257

Resp. to Office Action of Apr. 24, 2006

UTILITY PATENT

B&D No. TN -2239

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Frederick R. BEAN et al.

Serial No.: 10/054,257

Examiner: P. Nguyen

Filed: January 22, 2002

Group Art Unit: 3724


For: MITER SAW

Assistant Commissioner for Patents  
Washington, DC 20231

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**RESPONSE TO RESTRICTION REQUIREMENT**

I, Adan Ayala, PTO Reg. No. 38,373, hereby certify that this correspondence  
is being facsimile transmitted to the Patent and Trademark Office Fax No. 571-273-8300  
(703) 873-9900 on 5-17-06

 Adan Ayala

Dear Sir:

This is in response to the Office Action mailed on April 24, 2006.

The Examiner issued a restriction requirement, calling for the election of one of the  
following inventions: Group I (Claims 1-7); Group II (Claims 9-10); and Group III (Claims 13-16).  
Applicants respectfully traverse such requirement.

The restriction requirement is improper for several reasons. First, the Examiner would  
not suffer an additional burden in searching the entire application. Second, the timeliness of this  
Restriction should warrant continued prosecution on all claims.

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The restriction requirement is improper as the Examiner would not suffer an additional burden. If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it may include claims to distinct or independent inventions. MPEP § 803.

In the present case, the Examiner has been actively reviewing this case since as early as March 2004. The Examiner has issued 5 previous substantive Office Actions on all claims. Accordingly, the Examiner has done plenty of searching in this area and on these claims during the last few years. It is absurd that the Examiner would now find that examining 3 groups of claims is burdensome, when the Examiner has been doing that for the last few years.

Furthermore, the areas of searching for the three groups are closely interrelated. All three fall within the same class (83) and are recognized to be close subclasses by the PTO. For example, attached as Appendix A is the PTO's definition for class 83/subclass 468.3. In such definition, the PTO tells Examiners to search subclasses 477 and higher. Accordingly, the Examiner would have to also search class 83/subclass 478, which pertains to Group III, when searching for references related to Group I.

As to Group II, the independent claim has not changed since it was filed. Thus, the Examiner would have done all the necessary searches for the Group II claims.

In other words, if the Examiner has already done the search for Group II, and will have to do a search in two areas for Group I, one of the areas being the sole subclass applicable to Group

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III, then the Examiner would not incur any additional burden in examining all three groups.

Accordingly, the restriction requirement is improper and should be withdrawn.

Furthermore, a restriction requirement issued after four years of pendency and over two years of active examination violates MPEP § 811. According to such section, "the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required."

During a phone conversation on April 28, 2006 with the Examiner, the Examiner noted that the restriction is now proper because the last amendments in independent Claims 1 and 13 erased any overlap between the three groups. This is ludicrous. The three groups were always within their respective subclasses. The Examiner should have issued a restriction at the beginning of prosecution. After that (and after searching all three groups for two years), the Examiner has to show that there is a serious burden if the restriction is not required.

The Examiner has not shown a serious burden. The Examiner has argued that group I "has separate utility such as the wear ring can be used as a bearing in a rotatable surface of a rounded dining table." That would be correct if Applicants were trying to invent a wear ring. However, Applicants claim a miter saw with a wear ring, not a dining table or a trolley wheel assembly with wear rings. Since a search under the appropriate subclass would include the sole

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subclass necessary to examine Group III, the Examiner has failed to establish a "serious burden." Therefore, the restriction requirement should be withdrawn and examination should continue on all three groups.

Nevertheless, the Examiner has advised Applicants that a response to the restriction requirement must include an election. While Applicant believes this restriction requirement to be improper, Applicant hereby elects Group III.

No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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